

## **II. RESPONSE TO OFFICE ACTION**

### **A. Status of the Claims**

Claims 1-48 were pending at the time of the Action. Claims 1, 3, 4, 6, 8-10, 14, 17-19, 28, 32, 34, 35, 40, 43, and 46 have been amended. Claims 2, 5, 7, 11-13, 15-16, 20, 27 and 29-31 have been cancelled. Claims 49-110 are new and contain combinations of elements from previously pending claims. No new matter has been added via the amendments to the previously pending claims or the addition of the new claims. Support for all amended and new claims can be found in the specification and claims as filed. All amendments are made without prejudice or disclaimer, and Applicants reserve all rights to prosecute claims of a broader or narrower scope in this or future cases.

### **B. Claims 1-8, 10-11, 22-26, 34 and 36-47 Are Not Anticipated by Lim**

Claims 1-8, 10-11, 22-26, 34 and 36-47 are rejected under 35 USC § 102(e) as anticipated by Lim *et al.* (US 6,461,391) (“Lim”). The Action alleges that Lim teaches a hair dyeing composition comprising the cationic direct dyes as claimed and an oxidation base of cationic tertiary para-phenylenediamine having a formula (1), which has all the limitations of claimed formula (I), when in the reference formula (1), R, R1, and R2 are alkyl radicals, R4 is a hydrogen or an alkyl radical and R5 is a hydrogen atom as claimed in claims 1-8 and 10-11, and when in the claimed formula (I), R2 represents the onium radical Z of the claimed formula (II), R3 is a hydrogen atom, n is 1 or 0, and R1 is an alkyl radical. The Action also contends that Lim teaches “a polyol of propylene glycol as claimed in claim 1.” Applicants traverse. The present claims are not anticipated by Lim.

As an initial point, Applicants would point out that current independent claims 1, 49, and 80 each incorporates within their text the subject matter that the Action found not to be anticipated by

Lim. Specifically, current claim 1 incorporates the subject matter of previous claims 27, 30, and 31 in the definition of the “polyol” and none of these previous claims were rejected as anticipated by Lim. New independent claim 49 differs from claim 1 in that it incorporates the subject matter of previous claims 28, 30, and 32, none of which are rejected as anticipated in the Action. Likewise, new independent claim 80 incorporates the subject matter of previous claims 28, 30, and 33 into its body, and none of these claims have been rejected over Lim. Accordingly, each of independent claims 1, 49, and 80, as well as their dependents, are not anticipated by Lim.

In addition, Applicants note that formula (1) of Lim is distinct from formula (I) of the current claims, at least because it cannot reasonably be argued that Lim discloses formula (I) of the present claims when R2 represents the onium radical Z of the claimed formula (II) in which  $x=1$ . This point is supported by the Action’s statement at p. 6 that “the prior art of record do not teach or disclose cationic para-phenylenediamine compounds of the claimed formula (II), in which x is equal 1.”

Furthermore, Applicants note that a dyeing composition comprising at least one polyol with a molecular weight of between 90 and 350 which corresponds to formula (V) is not taught by Lim. The Action contends that Lim’s disclosure of polyols such as carbitols, propylene glycol, and glycerin amounts to such a teaching. Applicants note that none of these polyols is a polyol with a molecular weight of between 90 and 350 which corresponds to formula (V), as required by claim 1. Lim’s general reference to “polyols” does not anticipate the specific polyols required by claim 1 because Lim’s generic disclosure of “polyols” encompasses a vast number or even an infinite number of compounds, and thus the specific polyols of claim 1 cannot be “at once envisaged” within the generic chemical formula of Lim. *See In re Petering*, 301 F.2d 676 (CCPA 1962); MPEP § 2131.02.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); MPEP § 2131. Additionally, a compound can only be anticipated if the disclosure of a single reference places the compound in possession of the public. *See In re Brown*, 329 F.2d 1006, 1011 (CCPA 1964). Such is not the case with Lim, which does not sufficiently disclose the composition of the present claims.

In light of the foregoing, the rejection of claims 1-8, 10-11, 22-26, 34 and 36-47 as anticipated by Lim should be withdrawn.

### **C. The Obviousness Rejections Are Overcome**

#### **1. The Standard for Establishing a Prima Facie Case of Obviousness**

It is well settled that “[t]he examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” MPEP § 2142.

To establish a *prima facie* case of obviousness, the Action must show: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) a reasonable expectation of success; and (3) the prior art reference teaches or suggests all of the claim limitations. *See In re Vaeck*, 947 F.2d 488, (Fed Cir. 1991). With respect to element (1), “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

combination.” MPEP § 2143.01. If any one of the three elements is missing, an obviousness rejection cannot be maintained.

## **2. Claims 34 and 48 Are Not Obvious Over Lim**

Claims 34 and 48 are rejected as obvious over Lim. The Action alleges that Lim teaches: a hair dyeing composition comprising cationic direct dyes; an oxidation base of cationic tertiary para-phenylenediamine having a formula (I), which is identical to claimed formula (I); other primary intermediates (oxidation bases) such as para-phenylenediamines and couplers presented in the composition in the amount of 0.001 to 10%; and that the oxidation dyeing composition is mixed with an oxidizing agent immediately prior to application to the hair. The Action acknowledges that Lim does not teach the percentage amounts of the additional oxidation bases used in the composition (claim 34) nor a multi-compartment device (claim 48). However, the Action goes on to allege that it would have been obvious to one of ordinary skill in the art to optimize the amounts of oxidation bases in the dyeing composition and that as the oxidation composition is mixed with the oxidizing agent at the time of use, implying separate containers, a person of ordinary skill in the art would have been motivated to use a multi-compartment container. Applicants traverse.

First, Applicants note that claim 34 depends from claim 1, while claim 48 incorporates the composition of claim 1 by reference. For the reasons explained above, the composition of present claim 1 is not disclosed by Lim. Thus, Lim necessarily does not teach or suggest all of the claim limitations of claims 34 and 48. For at least this reason, a *prima facie* case of obviousness has not been established.

Second, in regard to the motivation to use a multi-compartment container, Applicants assume that the conclusory statements as to motivation imply that “common knowledge in the art” is the asserted source of motivation to use a multi-compartment device for holding the dyeing

composition. Applicants respectfully assert that the support for such motivation is inadequate. As stated by the Federal Circuit: “[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The Court further stated that “as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction,” but it made clear that such “expertise may provide sufficient support for conclusions [only] as to peripheral issues.” *Id.* at 1385-86, 59 USPQ2d at 1697. As the Board is so limited, so is the Examiner. The Federal Circuit has also held that:

[C]ommon knowledge and common sense on which the Board relied in rejecting [Applicant’s] application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency’s obligation... The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

*In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002). The Action only provides conclusory statements as to motivation and is apparently imposing the expertise of the Examiner as to what is common knowledge. Such statements in the Action are specifically held not to amount to “substantial evidence,” and as such are insufficient to establish a motivation to modify the teachings of Lim. If the Examiner is going to continue to rely on an allegation that common knowledge supports these rejections, he is requested to support this assertion with either a citation to prior art or an Examiner’s affidavit, pursuant to the requirements of MPE § 2144.03.

Furthermore, it appears that the Action is relying on hindsight to find a motivation to modify Lim. The use of hindsight, however, is not appropriate to establish a motivation to modify a reference. *See W.L. Gore Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). As stated in

MPEP § 2143.01, “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Be In light of the foregoing, the rejection of claims 34 and 48 as obvious over Lim should be withdrawn.ause the Action has not properly shown a motivation or suggestion to modify the teachings of Lim, a *prima facie* case of obviousness has not been established.

In light of the foregoing, the rejection of claims 34 and 48 as obvious over Lim should be withdrawn.

**C. Claims 28, 32-33, and 35 Are Not Obvious Over Lim in View of Braun**

Claims 28, 32-33, and 35 are rejected as obvious over Lim *et al.* in view of Braun *et al.* (US 5,972,044) (“Braun”). The Action alleges that Lim teaches a composition comprising polyol compounds, and that Braun teaches a composition comprising conventional cosmetic additive ingredients such as polyvalent alcohols of polyethylene glycol, 1,5-pentanediol, polyethylene glycol and tripropylene glycol. As both references involve the art of hair dyeing compositions and formulations, the Action alleges that one of ordinary skill in the art would have been motivated to modify the composition of Lim by incorporating the polyols taught by Braun to make the claimed compositions. The modification would have been obvious, the Action continues, because Lim suggests the use of polyols in the dyeing composition as the solvents, and Braun uses these solvents in the composition. Thus, according to the Action, one of ordinary skill in the art would expect such a composition to have similar properties those claimed absent unexpected results. Applicants traverse.

First, Applicants note that claims 28, 32-33, and 35 depend from claim 1. For the reasons explained above, the composition of present claim 1 is not disclosed by Lim. Thus, Lim necessarily

does not teach or suggest all of the claim limitations of claims 28, 32-33, and 35. For at least this reason, a *prima facie* case of obviousness has not been established.

Second, the Action has not shown a motivation to combine the references. The reason, suggestion, or motivation to combine prior art references must be based explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665 (Fed. Cir. 2000). With respect to the third *Ruiz* factor, neither Lim nor Braun discuss the problem described by the present invention. For example, Lim *et al.* does not discuss the weak and selective nature of shades obtained when using only para-phenylenediamines containing a pyrrolidine nucleus, nor does Braun. In contrast, the present application describes these problems (see, for example, page 3, lines 12-32 through page 4, lines 1-2), and the claimed invention overcomes them. The Action’s argument that one of ordinary skill in the art would be motivated to combine these references is weakened by the fact that neither of these references describe the problem solved by the present invention.

The Examiner has also failed to make a showing of the remaining two *Ruiz* factors: neither reference is said to provide the motivation to combine, and the Action does not assert that either reference is of special interest or importance in the field. Thus, none of the three requirements described in *Ruiz* have been satisfied by the Action .

Furthermore, it appears that the Action is relying on hindsight to find a motivation to combine Lim and Braun. The use of hindsight, however, is not appropriate to establish a motivation to modify a reference. See *W.L. Gore Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983).

As stated in MPEP § 2143.01, “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Although Braun appears to mention polyethylene glycols as conventional cosmetic additive ingredients, nothing in Braun suggests combining these additive ingredients with the cationic tertiary para-phenylenediamine of the present claims. Because the Action has not properly shown a motivation or suggestion to modify the teachings of Lim, a *prima facie* case of obviousness has not been established.

In light of the foregoing, the rejection of claims 28, 32-33, and 35 as obvious over Lim in view of Braun should be withdrawn.

#### **D. Conclusion**

In view of the above remarks, Applicants respectfully submit that the present case is in condition for allowance. Reconsideration of the application and claims is courteously solicited.



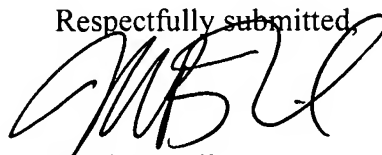
### **III. REQUEST FOR EXTENSION OF TIME**

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of three months to and including February 11, 2006, in which to respond to the Office Action dated August 11, 2005.

Pursuant to 37 C.F.R. § 1.17(a)(2), a check in the amount of \$1020.00 is enclosed, which is the fee for a three-month extension of time for a large entity. If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski Deposit Account No. 50-1212/LORE:010US.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3035 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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